

### **REMARKS**

Claims 1-37 are currently pending. On May 18, 2005, the Examiner rejected claims 6, 7, 12-14, 22-27, 36, and 37, objected to claims 15-17 as having allowable subject matter, and allowed claims 1-5, 8-11, 18-21, and 28-35. With this Amendment, claims 6, 7, 12, 16, 22, 36, and 37 are amended, claim 15 is canceled, and claims 38-40 are added. Applicant respectfully traverses the rejection and request reconsideration based on following remarks

#### **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 6, 7, and 22-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, the Applicant amends claims 6, 7, and 22 in order to distinctly claim the claimed invention and thereby, overcome the § 112, second paragraph rejection.

Claims 23-27 depend upon claim 22 and were rejected for the same reason as claim 22. Based on the amendment to claim 22, claims 23-27 are now distinctly claimed and overcome the § 112, second paragraph rejection,

In response to rejected claim 23, the phrase “passing the sonde...around the sonde cable” is supported at least by FIG. 3 and page 4, paragraph 52 (4:52).

Therefore, claims 6, 7, and 22-27 are allowable since Applicant has particularly pointed out and distinctly claimed the subject matter of the invention.

#### **Claim Rejections under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 12 and 37 under 35 U.S.C. 102(b) as being anticipated by Jenkins et al. (U.S. Patent No. 5,770,800; hereafter “Jenkins”).

In order to establish a proper 102 rejection, each element of the claim must be disclosed expressly or inherently within the prior art. "A claim is anticipated only if each and every

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

With respect to claim 12, Jenkins fails to teach "a break-away section coupled between the central portion and the gasket" (emphasis added). Jenkins discloses, in various embodiments, a seal 152 and a hollow shaft 58, but fails to disclose having a break-away section coupled between the hollow shaft 58 and the seal 152. Thus, Jenkins fails to expressly or inherently disclose "a break-away section coupled between the central portion and the gasket" (emphasis added). Therefore, Applicant's claim 12 is patentable over Jenkins.

Moreover, claims 13-14 and 16-17 depend from claim 12 and require all of the limitations of claim 12. Therefore, claims 13-14 and 16-17 are also patentable over Jenkins.

With respect to claim 37, Jenkins fails to teach "means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe" (emphasis added). Jenkins discloses having a seal, wherein the seal appears to be a circular shape. However, Jenkins fails to disclose having a sealing means comprising a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe. Thus, Jenkins fails to expressly or inherently disclose "means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a

tow line by the small diameter end substantially sealing against the inside wall of the pipe”

(emphasis added). Therefore, Applicant’s claim 37 is patentable over Jenkins.

Therefore, the rejection of claims 12 and 37 under § 102(e), as anticipated by Jenkins, is improper and should be withdrawn.

Applicant respectfully traverses the rejection of claims 12-14 and 37 under 35 U.S.C. 102(b) as being anticipated by Biggerstaff (U.S. Patent No. 4,866,978).

With respect to claim 12, Biggerstaff fails to teach “a break-away section coupled between the central portion and the gasket” (emphasis added). Biggerstaff discloses in various embodiments a diaphragm 33, a radial support member 49, and a plurality of arms 53a-h. However, Biggerstaff fails to disclose having a break-away section coupled between the diaphragm and the radial support member. Thus, Biggerstaff fails to expressly or inherently disclose “a break-away section coupled between the central portion and the gasket” (emphasis added). Therefore, Applicant’s claim 12 is patentable over Biggerstaff.

Moreover, claims 13-14 and 16-17 depend from claim 12 and require all of the limitations of claim 12. Therefore, claims 13-14 and 16-17 are also patentable over Biggerstaff.

With respect to claim 37, Biggerstaff fails to teach “means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe” (emphasis added). Biggerstaff discloses having a diaphragm, wherein the diaphragm appears to be a circular disc shape. However, Biggerstaff fails to disclose having a sealing means comprising a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the

inside wall of the pipe. Thus, Biggerstaff fails to expressly or inherently disclose “means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe” (emphasis added). Therefore, Applicant’s claim 37 is patentable over Biggerstaff.

Therefore, the rejection of claims 12-14 and 37 under § 102(b), as anticipated by Biggerstaff, is improper and should be withdrawn.

Applicant respectfully traverses the rejection of claim 36 under 35 U.S.C. 102(b) as being anticipated by Huber (U.S. Patent No. 6,082,183).

With respect to claim 36, Huber fails to teach a “means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe” (emphasis added). Huber discloses a removable test baffle that seals a pipe in order to test whether the pipe leaks or not, but fails to teach that the baffle comprises a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe. Thus, Huber fails to expressly or inherently disclose “comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe” (emphasis added). Therefore, Applicant’s claim 36 is patentable over Huber.

Therefore, the rejection of claim 36 under § 102(b), as anticipated by Huber, is improper and should be withdrawn.

Applicant respectfully traverses the rejection of claim 37 under 35 U.S.C. 102(b) as being anticipated by Donnelly (U.S. Patent No. 3,778,859).

With respect to claim 37, Donnelly fails to teach a “sliding pipe plug...means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe” (emphasis added). Donnelly discloses a squeegee that uses a rubber disc providing cleaning means to clean the pipe, but Donnelly is silent with respect to whether the rubber disc is firm enough to substantially seal against the inside wall of the pipe. Thus, Donnelly fails to expressly or inherently disclose “sliding pipe plug...means for sealing against the inside wall of a pipe coupled to the means for attaching, wherein the sealing means comprise a conical section having a small diameter end and a large diameter end attached to the means for attaching to a tow line by the small diameter end substantially sealing against the inside wall of the pipe” (emphasis added). Therefore, Applicant’s claim 37 is patentable over Donnelly.

Therefore, the rejection of claim 37 under § 102(b), as anticipated by Donnelly, is improper and should be withdrawn.

#### **Allowable Subject Matter**

Applicant thanks the Examiner for indicating that claims 15-17 would be allowable if they included the features of the claims from which claims 15-17 depend. Applicant has amended independent claim 12 to include the allowable subject matter of claim 15. As a result, Applicant cancelled claim 15 and corrected the dependency of claim 16. Therefore, as indicated

by the Examiner, claim 12 is allowable over the prior art. Claims 13-15 and 16-17, which depend on claim 12, are patentable for at least the same reasons as claim 12.

**New Claims**

New claims 38-40 have been added and are similar in scope to independent claims 1, 12, 18, 36, and 37. Therefore, new claims 38-40 are patentable for at least similar reasons as independent claims 1, 12, 18, 36, and 37.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 18, 2005

By: \_\_\_\_\_

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